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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,512	11/30/2000	Teruhiko Imoto	001431	5196

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EXAMINER

MERCADO, JULIAN A

ART UNIT PAPER NUMBER

1745

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/701,512

Applicant(s)

IMOTO ET AL.

Examiner

Julian Mercado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11-25-03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2, 4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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## DETAILED ACTION

### *Remarks*

This Office action is responsive to applicant's amendment filed November 25, 2003.

Claims 2, 4, 5 are pending.

This Office action presents a new ground of rejection and is therefore made NON-FINAL.

### *Claim Objections*

The objection to claim 2 has been withdrawn.

### *Claim Rejections - 35 USC § 102 and 103*

The rejection of claims 2, 4 and 5 under 35 U.S.C. 103(a) as obvious over Ise (U.S. 5,943,545) has been withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 2, 4 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Ise (U.S. Pat. 5,943,545).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

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CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The rejection of claims 2 and 5 under 35 U.S.C. 102(e) has been discussed in detail in the previous Office action. The examiner maintains that it would naturally flow for the Mn in Ise to inherently move to the surface of the hydrogen absorbing alloy as claimed, as applicant has not shown that the claimed invention distinguishes over the reference. *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977) and *In re Spada*, 15 USPQ 2d 1655 (Fed. Cir. 1990)

The examiner notes that though applicant has further amended the scope of the present claims in further defining the second step such that "at least one of nickel compound and cobalt compound is added", Ise actually anticipates this feature to the extent that both a nickel compound such as nickel hydroxide and a cobalt compound such as cobalt hydroxide are added to a hydrochloric acid solution such that the initial pH thereof is in the range of 0.7 to 2.0, e.g. a pH of 1 or 2. (col. 4 line 45-61)

Thus, claims 2 and 5 are anticipated by Ise.

While the examiner acknowledges applicant's statement on the record that both the Ise reference and the application are at present commonly assigned, it is unclear based on applicant's statement if in fact both the Ise reference and the application were commonly owned, or subject to an obligation of common assignment, *at the time the invention was made*. [emphasis added] Applicant's notation of the overlap in filing/pending dates of the Ise reference and the present application are noted, however, applicant is requested to restate more clearly that the common ownership was in fact at the time the invention was made. Applicant's mere paraphrasing of the

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relevant sections of the 35 U.S.C. 103 (c) statute does not remedy these ambiguities with respect to common ownership.

As to dependent claim 4, the previous Office action had set forth that the amount of nickel or cobalt in the acid solution so as to fall within the instant range of 0.3% to 5.0% by weight of the hydrogen storage alloy are optimizable parameters for a result-effective variable. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980) This ground of rejection under 35 U.S.C. 103(a) is withdrawn in favor of Ise actually teaching with sufficient specificity that the nickel compound or cobalt compound are present at 1 wt %. (col. 4 line 31, line 55-61) Ise is considered to teach an amount of nickel or cobalt in the acid solution to the extent that 1 wt. % falls within the claimed range of 0.3% to 5.0% by weight.


Thus, claim 4 is anticipated by Ise.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Patrick Ryan  
Supervisory Patent Examiner  
Center 1

